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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,245	07/28/2003	John W. Barrus	74451P158	7586

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EXAMINER

CAPUTO, LISA M

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/629,245

Applicant(s)

BARRUS, JOHN W.

Examiner

Lisa M. Caputo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed 24 June 2005.

Claim Objections

2. Claims 8 and 19 are objected to because of the following informalities:

Regarding claims 8 and 19: Proper antecedent basis is needed for the "guard area" limitation claimed. The "guard area" is not mentioned in the previous claims on which 8 and 19 are dependent. Examiner is interpreting the guard area as the area around the code.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8, 12-19, and 24-30 are rejected under 35 U.S.C. 103(a) as being obvious over Elliott et al. (U.S. Patent Application Publication No. 2004/0108381, from hereinafter "Elliott") in view of Nishijima et al. (U.S. Patent No. 5,431,288, from hereinafter "Nishijima").

Elliott teaches a device for scanning and printing barcodes. Regarding claims 1, 14, and 28-30, Elliott teaches an apparatus (barcode replicator 100) and method for capturing an original machine-readable code (MRC) at a location of a document, and a

controller for generating a new MRC based on the original MRC, the new MRC representing the same data of the original MRC and replacing the original MRC with the new MRC when it is taught that the method includes scanning a barcode at a first location with a device, storing the scanned barcode in a memory in the device, and printing the barcode at a second location with the device, wherein the second and first locations are not the same (see Figures 1 and 5, abstract, paragraphs 20-28 and 40). Further, Elliott teaches that the replicator could repair damaged barcodes by noticing that they are invalid, perhaps because the paper in the area is mangled, and then affixing a sticker over the top. In this way, individuals already manually working with the pages could assure that the barcoding identification system works later when being read by a machine (see paragraph 44). Hence, Elliott teaches that the new code is able to replace the original code.

Although Elliott teaches that a sticker with the new code is able to be placed over the top of the paper area, Elliott fails to specifically teach that the new MRC is located at substantially the same location as the original MRC with respect to the rest of the contents of the document.

Nishijima teaches a mail sorting apparatus. Nishijima discloses that the bar code printing area designation section 62 designates a bar code printing area 16 from the blank area detected by the blank area detection section 61, as shown in FIG. 3. The bar code printing section 80 prints a bar code 17 corresponding to the address read by the character recognition section 70 on the printing area 16. The character recognition section 70 performs character recognition of an address 11 on the basis of the video

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signal output from the scanning section 40, and the address position information and character height information output from the address position detection section 50, and converts the recognition result into bar code information. The bar code information is output to the bar code printing section 80 (see Figures 1 and 3, col 3 line 64 to col 4 line 27). Hence, Nishijima teaches that an original machine readable code can be captured via character recognition, and that a new barcode with the same address information is placed in the substantially same location with respect to the rest of the document.

In view of the teaching of Nishijima, it would have been obvious to one of ordinary skill in the art at the time the invention was made to be able to place the new machine readable code at substantially the same location as the original code so that if the original code is damaged, the new code would be able to display the same information in order for the system to continue to work properly (i.e. if the code is able to be read and processed, there is less room for error).

Regarding claim 2, Elliott teaches printing the document on a media with the new MRC via the printing mechanism 104 (see Figure 1, paragraphs 24-28).

Regarding claims 3-4, Elliott teaches that the document is scanned, and that the original MRC is recognized and its location determined (see Figure 1, paragraph 28).

Regarding claims 5-8 and 16-19, Elliott fails to specifically teach determining the dimensions of the original MRC, that the pixel boundaries are utilized in order to decide MRC placement and direction, and that the guard area is a clear or solid color.

Nishijima teaches that the document is scanned and that the original code is located and recognized by utilizing pixel boundaries (see Figure 2, col 3, lines 20-64). Further, Nishijima teaches that the guard area is a clear or solid color when it is taught that there is a clear blank area detection section 61 (see Figure 1, col 4, lines 1-20).

In view of the teaching of Nishijima, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the use of pixel boundaries in order to determine the placement and direction of the code because the use of pixels is standard in determining the orientation of an object, hence it is favorable to use because it is conventional and cost efficient. In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to ensure that the guard area is a clear or solid color so that the code itself is easy to recognize (i.e. the code will stand out from the background).

Regarding claims 12 and 24, Elliott teaches that the original MRC is a barcode (see Figures 1-5, paragraph 23).

Regarding claims 13 and 25, Elliott fails to specifically teach that the original MRC is an OCR text.

Nishijima teaches that the original address to be converted into a barcode is an OCR text when it is taught that the character recognition section 70 performs character recognition of the address 11 (see Figure 1, col 4, lines 20-27).

In view of the teaching of the teaching of Nishijima, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ OCR text as

the first code because OCR text is conventional and easy to read, which is favorable because since it is such an imaging standard, it is cost effective and efficient to utilize.

Regarding claim 15, Elliott teaches a scanner (scanner 109) to scan the document (see Figure 1, paragraph 21).

Regarding claims 26-27, Elliott teaches a communication interface capable of coupling to a network to receive and transmit documents over the network when it is taught that barcode replicator 100 may optionally include communications module 106 coupled and controlled by controller 103 to communicate with an external device. Communications module 106 may comprise network, telephone, wired, wireless or other well-known communication applications. Such an external device may be a computer system and/or database. Such a connection may be useful to obtain information (e.g., related to a scanned barcode) or to convey information (see Figure 1, paragraph 30).

4. Claims 9-11 and 20-23 are rejected under 35 U.S.C. 103(a) as being obvious over Elliott as modified by Nishijima and further in view of Torchalski (U.S. Patent No. 6,832,726). The teachings of Elliott as modified by Nishijima are discussed above.

Regarding claims 9-10 and 20-21, Elliott as modified by Nishijima fails to teach a user prompt regarding the quality of the code.

Torchalski discloses barcode optical character recognition. Torchalski teaches that it is determined whether the original MRC has a sufficient quality and prompts for input on whether the original MRC needs to be replaced if it is determined that the original MRC lacks sufficient quality (i.e. contrast/orientation), wherein the new MRC is

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generated and printed in response to the input received when it is taught that the computer software package prompts the user to confirm and/or change the characterizations about the objects on the label which the computer software package has made (see Figure 6, col 4, lines 20-35).

In view of the teaching of Torchalski, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ means for a user input so that the correct code is duplicated, with the correct specifications in order for the system to run efficiently. It is appropriate to combine Torchalski with both Elliott and Nishijima because all the systems taught by these references utilize the replication of barcodes. The teaching of Torchalski enhances the user-friendliness and usability of the entire system as taught by Elliott and Nishijima.

Regarding claims 11 and 22-23, Elliott as modified by Nishijima fails to teach that a certain signature is on the document which dictates further steps to be taken (i.e. the automatic generation of the code).

Torchalski teaches that if a certain signature of the document is read, the step of generating and printing the new MRC are performed automatically if the format of the document is recognized (see Figure 6, col 4, lines 20-35).

In view of the teaching of Torchalski, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a page signature with automatic code generation because this step allows for a more efficient system (i.e. by utilizing a certain signature, the system is able to process the code on its own, hence allowing the entire system to be faster).

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5. The applied Elliott reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Response to Arguments

6. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

7. Examiner appreciates applicant's arguments regarding the Torchalski reference and has cited new prior art in the form of Elliott and Nishijima.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Lisa M. Caputo** whose telephone number is **(571) 272-2388**. The examiner can normally be reached between the hours of 8:30AM to 5:00PM Monday through Friday. If attempts to reach the examiner by telephone are

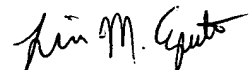
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unsuccessful, the examiner's supervisor, Michael G. Lee can be reached at **(571) 272-2398**. The fax phone number for this Group is (571) 273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [lisa.caputo@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lisa M. Caputo
AU 2876

September 26, 2005